

Supreme Court, U.S.
FILED

IN THE
Supreme Court of the United States

No. 79 889

IRONS AND SEARS,

Petitioner

v.

COMMISSIONER OF PATENTS AND TRADEMARKS,
Respondent

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA CIRCUIT**

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**PETITION FOR WRIT OF CERTIORARI TO THE
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Petitioner prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the District of Columbia Circuit entered in this proceeding on July 19, 1979 and adhered to by denial of a petition for rehearing on August 31, 1979.

THE OPINION BELOW

The opinion of the Court of Appeals filed July 19, 1979 is reported at — F.2d —, 202 U.S.P.Q. 798 and is reproduced *infra*, pages 1a-15a. The denial of the petition for rehearing was filed August 31, 1979 and is reproduced *infra*, page 16a. The opinion of the district court filed January 23, 1978 is unreported and is reproduced *infra*, pages 18a-23a.

JURISDICTION

The opinion of the Court of Appeals was filed on July 19, 1979. A timely petition for rehearing and suggestion for rehearing *en banc* was denied on August 31, 1979. This petition for writ of certiorari is filed within 90 days of the date of the denial of the rehearing petition. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. How is the disclosure mandate of the Freedom of Information Act, 5 U.S.C. § 552, to be reconciled with the exigencies of the patent system?

2. Is 35 U.S.C. § 122 a statute which "refers to particular types of matters to be withheld" within the meaning of exemption 3 (5 U.S.C. § 552(b)(3)) of the Freedom of Information Act (FOIA)?

3. Does the segregability clause of the FOIA, 5 U.S.C. § 552(b), apply to "applications for patents" or to "information concerning the same" contemplated by 35 U.S.C. § 122?

STATUTES INVOLVED

This case involves the Freedom of Information Act (FOIA), 5 U.S.C. § 552, specifically Sections (a)(3) and (b) including exemption 3 and the segregability clause thereof, and the patent laws, Title 35 U.S.C., specifically § 122 thereof.

5 U.S.C. § 552(a)(3) provides:

(a)

* * * *

(3) . . . each agency, upon any request for records which (A) reasonably describes such records and (B) is made in accordance with published rules

. . . shall make the records promptly available to any person.

5 U.S.C. § 552(b)(3) and the segregability clause provide:

(b) This section does not apply to matters that are—

* * * *

(3) specifically exempted from disclosure by statute (other than section 552b of this title), *provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld;*

* * * *

Any reasonably segregable portion of a record shall be provided to any person requesting such record after deletion of the portions which are exempt under this subsection.

(The italicized proviso of the statute was added by 1976 amendment. Pub.L. 94-409, § 5(b), 90 Stat. 1247.)

35 U.S.C. § 122 provides:

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

STATEMENT OF THE CASE

The FOIA Complaint (App. 1)¹ in this action seeks access to decisions of the Commissioner of Patents subse-

¹ All "App." citations refer to page numbers in the separately bound certified copy of the Appendix filed in the Court of Appeals.

quent to July 4, 1967 which pertain to the grant or refusal to grant a patent application filing date earlier than the date originally established by the Patent Office for such application and to all indices which relate to these decisions.

On March 11, 1976, respondent filed an "Affidavit of Rene D. Tegtmeyer," Assistant Commissioner of Patents (App. 19) and stated an intention "to submit to the Court shortly a Motion for Summary Judgment relying strongly on [that] Affidavit..." (App. 52).

On May 11, 1976, petitioner noticed the deposition of affiant Tegtmeyer (App. 53).

On June 30, 1976, respondent filed a "Motion to Dismiss or in the Alternative for Summary Judgment" (App. 57) and a "Motion for Protective Order" "vacating" Tegtmeyer's deposition notice (App. 61), *inter alia*, on the ground that:

unless discovery in FOIA cases is tied to a clear showing of need, any person filing a suit under the FOIA would be able to take the deposition of Government officials and pursue any other discovery permitted by the Federal Rules of Civil Procedure.

Petitioner thereafter filed a superseding notice to depose Tegtmeyer with a specification of documents to be produced at the deposition pursuant to Rule 30(b)(6) (App. 62),² and respondent countered with a "Further

² This portion of the notice states:

Pursuant to Rule 30(b)(5) [sic (6)] under the provisions of Rule 34, the defendant is requested to produce at the aforementioned deposition of Tegtmeyer:

(a) All documents which relate or pertain in any way to the "Affidavit of Rene D. Tegtmeyer" verified on the 11th day of March, 1976 in this cause; and

(b) All documents which relate or pertain in any way to any fact or other matter advanced in support of any motion for summary judgment which the defendant may file.

Motion" for a protective order to vacate the superseding Tegtmeyer deposition notice "[f]or the reasons" previously stated "which are incorporated herein by reference" (App. 63).

By order dated January 11, 1977 (App. 65), the district court granted the requested protective order, vacated the Tegtmeyer deposition notice, and stayed all discovery pending the disposition of the respondent's summary judgment motion.

On February 11, 1977, petitioner filed (i) a motion requesting

[A]n order to the effect that this Freedom of Information Act case involving the Commissioner of Patents and Trademarks as a defendant will not be handled in any different way because of its nature, but instead that all of the Federal Rules of Civil Procedure and the applicable substantive law will be applied in just the same way that they are applied in any other civil action, (App. 65)

(ii) a "Motion to Strike Affidavit of Tegtmeyer" (App. 66) for non-compliance with Rule 56(e), and (iii) a "Motion Under Rule 56(f)" (App. 66) asking the district court

to refuse the defendant's application for summary judgment or, in the alternative, to order a continuance until such discovery as may be necessary to probe the allegations of the affidavit supporting the summary judgment motion may be had.³

Some seven months later, on September 6, 1977 and without any hearing, the district court entered an order (App. 70) summarily *denying* all three of the aforesaid petitioner's motions.

³ The Rule 56(f) motion was supported by an appropriate "Affidavit" of counsel (App. 67) pointing out, *inter alia*, that facts necessary to justify opposition to the summary judgment motion could be obtained only through discovery (paragraph 4).

On October 13, 1977, petitioner filed its "Statement of Genuine Issue Pursuant to Local Rule 1-9(h)" (App. 71) setting forth 39 such issues and challenging most of the fact statements in the Tegtmeier affidavit.

On January 23, 1978, without any hearing and without permitting petitioner to pursue any discovery, the district court filed its "Memorandum" (pages 18a to 22a) granting respondent's motion for summary judgment. Rejecting petitioner's contention that discovery was necessary, the district court said that "[t]he issues here are purely legal ones and require no discovery" (page 18a, n. 1).⁴

The district court was "satisfied that 35 U.S.C. § 122 comes within the ambit of FOIA exemption 3" (page 21a). "After careful review of the entire record in this case," the district court judge concluded "that the [filing date] decisions . . . qualify as information concerning [patent] applications so as to be exempt from mandatory FOIA disclosure pursuant to 35 U.S.C. § 122 and 5 U.S.C. § 552(b) (3)" (page 21a). For reasons that its Memorandum does not set forth, the district court was "persuaded that filing date decisions differ significantly from the unpublished manuscript decisions in issue in *Irons v. Gottschalk*, [548 F.2d 922 (D.C. Cir. 1976)] . . ." (page 21a). The district court concluded "that in the light of the statutory purposes of 35 U.S.C. § 122"

⁴ Inconsistent with that conclusion, the Memorandum proceeds to posit the grant of summary judgment on many of the facts placed directly in issue by the petitioner's Rule 1-9(h) statement—and as to which petitioner was denied any discovery.

Although the district court's Memorandum avoids express reference to the Tegtmeier affidavit—which it frequently paraphrases—there is no other *record* source of any of the "undisputed" facts underpinning the summary judgment.

⁵ As evidence of the "statutory purposes of 35 U.S.C. § 122," the district court cited only *Sears v. Gottschalk*, 502 F.2d 122, 128-130 (4 Cir. 1974), *cert. den.*, 425 U.S. 904 (1976).

and given the type of documents involved, there is no basis for awarding mandatory access under the FOIA" (page 22a) to the requested decisions.

On appeal, petitioner framed issues subsumed by the questions presented on this petition—including whether "The Federal Rules of Civil Procedure, including the discovery provisions thereof, apply to Freedom of Information Act cases equally with other civil suits" and whether Rules 56(e) and (f) apply to agencies of the United States government as well as to other parties.

The opinion of the Court of Appeals "treats only the substantive issues . . ." because it deemed appellant's "procedural contentions relating to various rulings and controversies below" to be lacking "in merit" (page 5a, n. 19)—and so affirmed the district court's denial of petitioner's motion that this FOIA case "not be handled in any different way because of its nature".

The appellate court recognized that the seminal problem it faced was to "reconcil[e] the disclosure mandate of the FOIA with the exigencies of the patent system" (page 10a). It deemed the "key question" to be

whether patent applications and information concerning them qualify by virtue of 35 U.S.C. § 122 as materials "specifically exempted from disclosure by statute" for purposes of the third exemption of the FOIA, 5 U.S.C. § 552(b) (3), and thus may be kept in confidence by the PTO. . . . (page 5a)

After quoting Exemption (3) of the FOIA, the appellate court correctly noted that

The proviso that makes up the major part of this exemption was added to it in 1976 by the Government in the Sunshine Act. Congress' goal was to overrule legislatively the Supreme Court's decision in *Administrator, FAA v. Robertson*, 422 U.S. 255 (1975), which had given an expansive reading to the

version of Exemption 3 then in force. The amended text and its legislative history make clear that Congress did not want the exemption to be triggered by every statute that in any way gives administrators discretion to withhold documents from the public. On the contrary, Congress intended exemption from the FOIA to be a legislative determination and not an administrative one. It provided that only explicit nondisclosure statutes that evidence a congressional determination that certain materials ought to be kept in confidence will be sufficient to qualify under the exemption. But it did provide that such statutes would be sufficient. (page 6a) (Footnotes omitted.)

The Court of Appeals recognized "at the outset that Section 122 fails to satisfy fully the first part of the proviso in Exemption 3. The Patent Act simply is not a statute that requires nondisclosure 'in such a manner as to leave *no* discretion on the issue.' (Emphasis added.) Rather it permits the Commissioner to release information concerning patent applications when he finds there exist the appropriate 'special circumstances.'" (page 8a)

The court then denigrates this undefined "special circumstances" discretion which the statute vests in the Commissioner as "the mere presence of some residual administrative discretion" which "does not take Section 122 out of Exemption 3" (page 8a).⁶ The court held that:

⁶ The court below also characterized § 122 as setting forth "a discretionary but *apparently narrow* 'special circumstances' exception" (page 9a).

These observations—essential to the lower court's qualification of § 122 under exemption 3—are totally without record support, and the opinion cites none. The "apparently narrow" *ipse dixit* is, in fact, contrary to the Commissioner's own consistently broad and always arbitrary interpretation of § 122 as giving him unfettered discretion to withhold from or release to the public whatever patent applications and "information concerning" them he chooses.

For example, (i) as the opinion recognizes, § 122 applies, without qualification, to "patent applications including . . . applications

Section 122 does satisfy the second prong⁷ because it "refers to particular types of matters to be withheld"—namely, patent applications and information concerning them. (page 8a) (Footnote omitted.)

The court ignored the first alternative of the "second prong"—i.e., "*particular criteria* for withholding"—tacitly acknowledging that the "special circumstances" language of § 122 constitutes no such "particular criteria".⁸ Nevertheless, the court held that the statute's uncabined reference to "patent applications and information concerning the same" is a reference to "*particular types of matters* to be withheld".

Seemingly uncomfortable with that conclusion in view of the fact stressed in petitioner's briefs and not controverted by respondent that the apposite language of § 122 "encompasses every piece of paper in the patent operation of the Patent and Trademark Office" (App. Br. 8) and hence does not "refer to *particular* types of matters to be withheld", the appellate court departed from the language of § 122 to posit its ruling upon a "broader view", i.e., that "Congress seems to have intended to draw

which have culminated in the issuance of a patent" (page 3a) which *are* made available to the public by 37 C.F.R. § 1.11, (ii) as of March 1, 1977, the Commissioner, in a sudden switch of position from the practice of many years standing, promulgated an amended 37 C.F.R. § 1.11(b) pursuant to which an entire subclass of "pending applications"—to wit all pending *reissue* applications (see 35 U.S.C. § 251)—are available to the public, and (iii) also on March 1, 1977, consistent with the decision in *Irons v. Gottschalk*, 548 F.2d 992 (1976), *cert. den.*, 434 U.S. 965 (1977), the Commissioner promulgated an amended 37 C.F.R. § 1.14(d), to make administrative decisions of precedential value available to the public.

⁷ I.e., the "B" prong of exemption (3) which is limited to a statute which "establishes particular criteria for withholding or refers to particular types of matters to be withheld".

⁸ An issue squarely raised below and never seriously contested by respondent.

a bright line shielding from disclosure all information concerning patent applications. . ." (page 11a).

This "broader view" shibboleth is unsupported by the record in this case. More significantly, the premises by which it is underpinned are contradicted by available evidence which the discovery foreclosed by the orders of both lower courts would have adduced.

The Court of Appeals bottomed its "broader view" on a speculation that "[t]here can be little doubt that a holding permitting FOIA access to [patent] applications would jeopardize the patent system by permitting competitors to divine or actually to secure information concerning inventions prior to the issuance of a patent" (page 8a).

Recognizing, however, "appellant has not requested actual patent applications. . . . It seeks only PTO decisions granting or denying petitions for earlier filing dates" (pages 9a-10a), the lower court adopted the extreme position, wholly unwarranted by the sparse record,⁹ that

Earlier filing date decisions identify the applicant, the invention, and the filing date. As a result, their disclosure [of the earlier filing date decisions sought by petitioner] would lead to some of the same harms as would the disclosure of the applications themselves. (page 10a).

However, in support of this imagined jeopardy to "the patent system", the appellate court cites only *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 616 (9 Cir. 1978) which affirmed a "judgment dismissing [the] complaint for failure to state a claim upon which relief can be granted." 577 F.2d at 610. Hence, in *Lee*, as in this case, there is no factual basis in the record to support the

⁹ No such "decisions granting or denying earlier filing dates" appear in the record.

imagined "jeopardy" to "the patent system" which, alone, is advanced by the lower court to justify its ruling.

The Court of Appeals in this case also acknowledged that its ruling conflicts with the recent, earlier decision of the same court in *Irons, supra*, stating:

A . . . partial decision was chosen by this court in *Irons v. Gottschalk, supra* note 9, to achieve just such a reconciliation [of the disclosure mandate of the FOIA with the exigencies of the patent system] (page 10a, note 30)

In *Irons, supra*, a panel comprised of Mr. Justice Clark, Chief Judge Bazelon and Judge Robinson considered an FOIA request for 175 volumes of unpublished manuscript decisions of the various PTO tribunals. In an opinion for the Court filed by Mr. Justice Clark, that panel held in effect that the segregability clause of § 552(b) applied to Patent Office decisions. The opinion states that such decisions include "both exempt and non-exempt material," that "35 U.S.C. § 122 . . . exempts only portions of the requested material *containing detailed* information and salient knowledge pertaining to patent applications. . .,"¹⁰ and that ". . . [t]hose portions of the decisions which contain protected information can be excised in order that the non-exempt portions can be disclosed. . ." 548 F.2d at 996-997.¹¹

The panel in this case, consisting of Chief Judge Wright and Judges Robinson and Robb, held precisely to the contrary:

¹⁰ Similarly, the Court in *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 616 (9 Cir. 1978) stated that the "purpose of the confidentiality proviso" of § 122 is to prevent "*inventor's discoveries*" from becoming "public knowledge before a patent is secured."

¹¹ The *Irons* court remanded ". . . to the district court for determining which materials are exempt and which are non-exempt with directions to the Patent Office to excise [the exempt portions]". *Ibid.* The case is still pending, on remand, before the district court.

We must, therefore, decide whether these administrative decisions qualify as "information concerning" patent applications for purposes of Section 122.

Appellant invites us to conclude that the materials at issue here do not so qualify and, in the alternative, suggests that even if they do they must be released once those portions reasonably deemed confidential have been deleted. We decline to follow appellant's lead on both counts. . . .

Congress seems to have intended to draw a bright line shielding from disclosure *all* information concerning patent applications. Had it wanted to insulate only some information concerning them, or otherwise to inaugurate a regime of selective excision, it could easily have so specified. Instead, it enacted a flat prohibition which we do not feel free to ignore. . . . (pages 10a-11a)

In its accompanying footnote 31, the Court of Appeals states that "since we conclude that § 122 exempts the PTO's earlier filing date decisions in their entirety, the segregability clause [of § 552(b)] has no application to the present case" (page 11a).

Petitioner filed a timely request for rehearing calling attention to this conflict in decision and a Suggestion for Rehearing *En Banc*, deemed appropriate in view of the rule in the circuit that a recent decision of one panel of the court cannot be overruled by another panel but only by the court *en banc*. See *United States v. Bryant*, 471 F.2d 1040, 1046 (D.C. Cir. 1972); *United States v. Caldwell*, 543 F.2d 1333, 1369, n. 19 (D.C. Cir. 1976), McKinnon J. concurring, in part, and dissenting, in part.

The request for rehearing and suggestion for rehearing *en banc* were each summarily "denied" by orders dated August 31, 1979, *infra*, page 16a and 17a.

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The decision in this case is in direct conflict with the earlier decision of the same court in *Irons v. Gottschalk*, 548 F.2d 992, 995 (1976) on the issue of whether the segregability clause of the FOIA applies to "information concerning" patent applications within the meaning of 35 U.S.C. § 122. The panel in this case held that § 122 constitutes a "flat prohibition on disclosure" of such information—whereas the panel in *Irons* held that "§ 122 . . . exempts only portions of the requested material containing detailed information and salient knowledge pertaining to patent applications", that ". . . [t]hose portions of the decisions which contain protected information can be excised in order that the non-exempt portions can be disclosed. . .",¹² and that "barring any overriding concerns to the contrary, the Commissioner may, of his own accord, release any information requested. . . ." 548 F.2d at 996-997.¹³

¹² This interpretation accords with the view of the Ninth Circuit that the "purpose of the confidentiality proviso" of § 122 is to prevent "*inventor's discoveries*" from becoming "public knowledge before a patent is secured." See *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 616 (9 Cir. 1978).

¹³ In the context of the patent laws, conflict in decision is of particular importance. On February 3, 1977, following the decision in *Irons, supra*, the Patent Commissioner amended 37 C.F.R. 1.14(d) to make more explicit the conditions under which significant decisions of the Patent and Trademark Office will be made available to the public. The Commissioner's announcement states that the amended regulation "is considered to place a duty on the Patent and Trademark Office to identify significant decisions and to take steps necessary to inform the public of such decisions in whole or in part" and that

A large majority of the comments received were favorable. Several commentators felt that more decisions would be made available as a result of the proposed section and that it would assist in publicizing aspects of Office procedure which may not have been available previously. 42 F.R. 5288.

2. This conflict in decision subsumes a far more fundamental issue—as indeed the Court of Appeals in this case recognized, namely, reconciliation of the broad “disclosure mandate of the FOIA with the exigencies of the patent system”.

(a) no such judicial reconciliation based on a reasoned analysis of either statute has ever been made. It is long overdue, and it is essential to the proper administration of both the patent laws and the FOIA.

(b) The decision in this case is the most recent in a series of decisions which abjure reasoned analysis and foreclose discovery to hold, in effect, that the PTO is immune from the disclosure mandate of the FOIA on the basis of an overbroad reading of § 122.¹⁴

The conclusion of the Court of Appeals that

Section 122 does satisfy [exemption 3] because it “refers to *particular* types of matters to be with-

¹⁴ This unworthy record includes the initial decision in *Irons v. Schuyler*, 465 F.2d 608 (D.C. Cir. 1972) in which the Patent Commissioner induced a favorable ruling on the basis of an affidavit later shown to be untrue. In the second appeal in that case, the trial judge (i) engaged in secret and *ex parte* communications with the Patent Office and its counsel, (ii) condoned the untruthful affidavit aforementioned, and (iii) condoned the destruction of relevant evidence by the Patent Office. See *Irons v. Gottschalk*, 548 F.2d 922 (D.C. Cir. 1976). In *Sears v. Gottschalk*, 502 F.2d 122 (4 Cir. 1974) the court *sub silentio* condoned the mysterious voluntary filing by affiant of an extensive non-party affidavit of P. J. Federico, an ex-Patent Office employee then in private practice which the plaintiff had no opportunity to test by deposition or otherwise. In *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 614-618, the Court affirmed dismissal of the complaint for failure to state a claim on the speculation, having no record support whatever, that, if the abandoned patent applications at issue in that case were disclosed, “destruction of the patent system” would follow, 577 F.2d at 617. And it is only the latter unbridled and unsupported speculation that is cited by the appellate court in this case to support its “broader view” that the filing date decisions sought by petitioner would “jeopardize the patent system” (page 9a).

held”—namely patent applications and information concerning them (page 8a; emphasis added)

cannot be squared with the subsequent assertions in the same opinion that § 122 “draw[s] a bright line shielding from disclosure all information concerning patent applications” and is “a flat prohibition on disclosure”.

Such a “flat prohibition”, of course, is *not* a definition limited to “*particular* types of materials to be withheld”—but extends instead to the virtual entirety of the files of the PTO.

(c) The lower court’s construction of exemption 3 completely eviscerates it. The standard adopted below for FOIA exemption, which is whatever the agency chooses to put in its regulations, is no proper substitute for the chosen standard of Congress. Confiding the power to decide what to withhold or disclose to the agency, subject only to the limitation of the agency’s sense of self-restraint, if it has one, runs diametrically counter to the congressionally stated purpose of the 1976 Sunshine Act—as, indeed, the lower court itself acknowledged.¹⁵

The kind of particularity that 5 U.S.C. § 552(b) (3) (B) must refer to, if it is to make any sense in the context of the purpose of the Sunshine Act, would have to be “particular types of matters” that must be kept secret to carry out a particular governmental purpose.

In the present posture of this case there is no showing of the kind of rational connection between withholding the requested decisions and a particular policy that could qualify them as “particular types of matters to be withheld” under paragraph (3) (B).

¹⁵ As the lower court put it, “Congress intended exemption from the FOIA to be a legislative determination and not an administrative one” (page 7a).

(d) That § 122 is the very sort of statute Congress sought to reach in the Sunshine Act is even more specifically shown by a further part of the legislative history. Congress expressly mentioned 49 U.S.C. § 1504 and 42 U.S.C. § 1306 as two examples of exemption statutes that henceforth would not qualify under the Sunshine Act.¹⁶ Section 1504 allowed the Administrator of the FAA to withhold information from public disclosure if, in his judgment, disclosure was not in the public interest. Section 1306 prohibited disclosure of a wide range of social security information except as the Secretary of HEW or Secretary of Labor "may by regulations prescribe." That section does *not* cover all information of any kind in the Secretary's possession, but Congress still considered the section to be too broad for the Sunshine Act. Clearly, § 122 is indistinguishable from the two statutes Congress named as examples of exemptions from FOIA to be eliminated by exemption 3.

(e) The lower court departed from the plain meaning of the language of § 122, to posit its ruling instead on a "somewhat broader view" of what it imagined "Congress *really* wanted"—all without any reference whatever to the apposite legislative history.

On that basis, the appellate Court asserted without reference to the record that

There can be little doubt that a holding permitting FOIA access to such applications would jeopardize the patent system by permitting competitors to divine or actually secure information concerning inventions prior to the issuance of a patent[,] (page 9a)¹⁷

¹⁶ See the Conference Report, H. Rep. No. 94-1441, in 10 U.S. Code Cong. & Admin. News, 94th Cong., 2d Sess., at 2244, 2261.

¹⁷ A conclusion contrary to common knowledge and having no support in the record of this case which the court below justified solely by reference (see *infra*, page 9a, n.28) to the Ninth Circuit's

and, also without reference to the record, that

Earlier filing date decisions identify the applicant, the invention,¹⁸ and the filing date. As a result, their disclosure would lead to some of the same harms as would the disclosure of the applications themselves. (page 10a)

Had remand for discovery been ordered, as it should have been, these *de novo* speculations, which the district court did not indulge, could easily have been discredited.

Even without any discovery, there is cogent evidence available to show that a practical reconciliation of the provisions of the FOIA with § 122 will not "jeopardize" or result in "destruction" of the patent system—but, instead would be entirely consistent with the manner in which that system is presently administered by the Commissioner and utilized by the public.

One example, in the specific context of the filing date decisions at issue in this case, is the February 2, 1977 amendment of 37 C.F.R. § 1.14(d) to impose a duty on the Commissioner to make significant PTO decisions "available to the public" with respect to which "[a] large majority of the comments received were favorable".

equally unsupported *ipse dixit* that access to abandoned patent applications would result in "destruction of the patent system. . ." *Lee Pharmaceuticals v. Kreps*, *supra*, 577 F.2d at 617.

¹⁸ The court's use of the word "invention" in this context is unfortunate if it is intended to suggest that these "filing date" decisions reveal any "detailed information and salient knowledge pertaining to" the invention subject matter sought to be patented. The "invention" is "revealed" only to the extent that the general subject matter to which it relates may be indicated by the brief "title" of the application involved. See the sample decisions *granting* a filing date which appear at App. 45, 47 and 49.

Hence, contrary to the inference which the use of the word "invention" in the opinion may invite, no disclosure of any allegedly "confidential" or "trade secret" information is involved in this case.

With respect to "patent applications"—and specifically pending patent applications from which the public could "actually secure information concerning inventions prior to the issuance of a [United States] patent"—it is noteworthy that the patent system has not been "destroyed" or "jeopardized" because

- (1) To obtain the benefit of the International Convention for the Protection of Intellectual Property, (i) foreign counterparts of United States patent applications must be filed abroad within one year of the United States filing date, (ii) the foreign filing must include a certified copy of the United States application, and (iii) copies of such United States applications are publicly available, on request by anyone from the foreign Patent Offices, long before the United States patent issues.

Virtually all commercially significant inventions are the subject of such foreign counterpart applications.

- (2) Pending United States patent applications become a part of the public record before the U.S. patent issues in the event of appeal from a PTO rejection to the Court of Customs and Patent Appeals pursuant to 35 U.S.C. § 141 or a civil action in the district court pursuant to 35 U.S.C. § 146.¹⁹
- (3) All pending applications for reissue pursuant to 35 U.S.C. § 251 are now publicly available pursuant to 37 C.F.R. § 1.11(b).
- (4) Pursuant to the Rules of the PTO including 37 C.F.R. § 1.226 pending patent applications are made available to adversary parties in interference proceedings conducted in accordance with 35 U.S.C. § 135(a).

¹⁹ See Dunner, *Court Review of Patent Office Decisions; Court of Customs and Patent Appeals* § 204(b), p. 2-29.

CONCLUSION

This Petition should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX

UNITED STATES COURT OF APPEALS
DISTRICT OF COLUMBIA CIRCUIT

No. 78-1200

Irons and Sears v. Dann, Commr. of Patents

Filed July 19, 1979

Before WRIGHT, *Chief Judge*, and ROBINSON and ROBB,
Circuit Judges.

Opinion for the court filed by *Chief Judge* WRIGHT.

WRIGHT, *Chief Judge*: Appellant seeks access under the Freedom of Information Act (FOIA)¹ to all decisions of the Patent and Trademark Office (PTO) disposing of requests by would-be patentees for a filing date earlier than the one initially assigned to their applications. The agency granted access to a limited portion of these decisions and declared that the rest were not reachable under the FOIA. Appellant filed suit to secure the documents withheld, and the District Court substantially affirmed the PTO's position. We find ourselves in accord in significant respects with the District Judge's conclusion that the bulk of the material sought is exempt from the Act. We remand, however, because we believe that one category of decisions as to which FOIA access was apparently denied is in fact fully subject to the Act. While limited, this remand may have the added benefit of permitting the agency to take a second look at its discretionary decision to release certain decisions while maintaining in secrecy others that appear in material respects to be indistinguishable.

I

The patent process is commenced, not surprisingly, by the filing of a patent application. Pursuant to 35 U.S.C. § 111 (1976) such an application must include a number

¹ 5 U.S.C. § 552 (1976).

of items, among them a specification describing the invention and claiming the subject matter which the applicant regards as his, a drawing (where appropriate), an oath, the signature of the applicant, and the required fee.² An application's filing date is the date on which the entire application was received by the Patent and Trademark Office. If an application is not complete at the time of initial filing, it is not assigned a filing date. Instead, the applicant is notified of the deficiency and the documents that were received by the PTO are in effect held in abeyance. If the applicant chooses to cure the defects or omissions he may do so, and his application will be given a filing date that corresponds to the date on which it was completed.³

In the course of patent examination proceedings the patent application's filing date may play a critical role. In fact, the grant or denial of a patent may in some circumstances turn upon the filing date assigned to the application.⁴ In light of this, applicants who have received a deferred filing date sometimes object to the date assigned to their application and petition the Commissioner of Patents and Trademarks for an earlier one. It

² See 35 U.S.C. §§ 111, 112, 113, 115 (1976).

³ See generally Affidavit of Rene D. Tegtmeyer, filed March 11, 1976, Appendix (App.) 19, 22-25. See also 37 C.F.R. §§ 1.53, 1.55(a) (1978).

⁴ 35 U.S.C. § 102 (1976) provides that a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * * *

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States[.]

is the decisions of the Commissioner and his assistants disposing of these petitions which are the subject of the instant litigation.⁵

Patent applications may be grouped into three categories.⁶ First are pending applications, which are exactly what the label suggests—applications that are either on the brink of the examination process or already enmeshed in examination proceedings. Second are applications which have culminated in the issuance of a patent. These are called patent files. And third are applications with regard to which proceedings have terminated without the issuance of a patent, either because of an unfavorable PTO determination or because the applicant has for some reason decided not to pursue the matter. These are called abandoned patent applications. Pursuant to 35 U.S.C. § 122 (1976) categories one and three are maintained in confidence by the PTO.⁷ Documents in category two, patent files, are public records open for inspection.⁸

In the spring of 1975, appellant, a law firm that seems to devote considerable resources to FOIA litigation against the PTO,⁹ filed a request for all decisions of the Commissioner granting or denying petitions for earlier filing dates and all indices pertaining to such decisions.¹⁰

⁵ Samples of such decisions are reproduced at App. 45-50. Additional samples appear in an addendum to the Appendix.

⁶ See *Sears v. Gottschalk*, 502 F.2d 122, 124 (4th Cir. 1974), *cert. denied*, 425 U.S. 904 (1976); Tegtmeyer Affidavit, *supra* note 3, App. 25.

⁷ See *Sears v. Gottschalk*, *supra* note 6, 502 F.2d at 124, 128-131. See also 37 C.F.R. §§ 1.14(a) & (b) (1978).

⁸ See 37 C.F.R. § 1.11 (1978).

⁹ See *Irons v. Gottschalk*, 548 F.2d 992 (D.C. Cir. 1976), *cert. denied*, 434 U.S. 965 (1977); *Sears v. Gottschalk*, *supra* note 6; *Irons v. Schuyler*, 465 F.2d 608 (D.C. Cir.), *cert. denied*, 409 U.S. 1076 (1972).

¹⁰ The original request is reproduced at App. 30-33. A letter clarifying that request appears at App. 35.

By letter of April 23, 1975 the PTO granted the request in part and denied it in part.¹¹ More specifically, the agency agreed to make available (1) in their entirety all decisions *denying* earlier filing dates contained in *patent files*, and (2) after deletion of confidential material all decisions *denying* earlier filing dates contained in *abandoned applications*. In addition, the PTO provided indices of the decisions to which access was granted. The agency declined to release decisions *denying* an earlier filing date that pertain to *pending applications* as well as all decisions *granting* earlier filing dates.¹² Appellant appealed administratively,¹³ and the agency adhered to its previous position.¹⁴

¹¹ App. 36-37.

¹² The agency's rationale for each facet of its response is not entirely clear. Its initial response states that decisions granting an earlier filing date "are not available for inspection and have not been indexed since they are not 'final opinions' in the adjudication of cases. See 5 USC § 552(a)(2). Those decisions which relate to pending applications are not available for inspection for the further reason that they are specifically exempted from disclosure by 35 USC § 122." App. 37. On its face this is a rather curious and incomplete statement. In the first place, it provides no justification for the PTO's determination that decisions denying an earlier filing date with regard to abandoned application files should be excerpted prior to their disclosure. Further, it fails to address the possibility that decisions granting an earlier filing date for abandoned applications and for applications that have issued as patents might be disclosable as reasonably described records under 5 U.S.C. § 552(a)(3) if not covered by the disclosure requirement of § 552(a)(2). The Tegtmeyer Affidavit, *supra* note 3, gives a somewhat expanded *post hoc* rationale for the agency response which cures some of these defects: It asserts that decisions lodged in abandoned applications are exempt from disclosure under 35 U.S.C. § 122 just like those lodged in pending files and suggests that the agency's decision to release excerpted portions of some of these decisions notwithstanding their exemption was a voluntary one in no way compelled by the FOIA. In large measure we uphold the interpretation and analysis which underlies this explanation.

¹³ App. 38-40.

¹⁴ App. 41-44.

On August 27, 1975 appellant filed suit in the District Court seeking disclosure of all filing date decisions withheld, along with pertinent indices.¹⁵ The District Court granted summary judgment in favor of the PTO on January 23, 1978.¹⁶ The court found that Exemption 3 of the FOIA, 5 U.S.C. § 552(b)(3) (1976), in conjunction with the provision of the patent statute requiring that patent applications be maintained in confidence, 35 U.S.C. § 122 (1976), shields the bulk of the decisions in suit from disclosure under the FOIA. This appeal followed.

II

The FOIA combines a strong disclosure mandate with nine rather specific exemptions.¹⁷ It is a commonplace that the former is to be generously construed while the latter are narrowly circumscribed.¹⁸ The key question posed by the instant litigation is whether patent applications and information concerning them qualify by virtue of 35 U.S.C. § 122 as materials "specifically exempted from disclosure by statute" for purposes of the third exemption to the FOIA, 5 U.S.C. § 552(b)(3), and thus may be kept in confidence by the PTO. The District Court held that they do so qualify, and we concur.¹⁹

¹⁵ The complaint is reproduced at App. 1. Appellant also sought in unexpurgated form those decisions which had been excerpted.

¹⁶ The District Court's Memorandum and Order appear respectively at App. 79 and 84.

¹⁷ 5 U.S.C. § 552(a) contains the disclosure requirements. The exemptions are set forth in 5 U.S.C. § 552(b).

¹⁸ See, e.g., *NLRB v. Robbins Tire & Rubber Co.*, 437 U.S. 214, 220-221 (1978); *Dep't of Air Force v. Rose*, 425 U.S. 352, 360-362 (1976).

¹⁹ Appellant has also raised a host of procedural contentions relating to various discovery rulings and controversies below. We have carefully considered these contentions and conclude that they are lacking in merit. Accordingly, our opinion treats only the substantive FOIA issues raised by this appeal.

Exemption 3 excludes from the coverage of the FOIA matters that are

specifically exempted from disclosure by statute (other than section 552b of this title), provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld[.]

5 U.S.C. § 552(b)(3). The proviso that makes up the major part of this exemption was added to it in 1976 by the Government in the Sunshine Act.²⁰ Congress' goal was to overrule legislatively the Supreme Court's decision in *Administrator, FAA v. Robertson*, 422 U.S. 255 (1975), which had given an expansive reading to the version of Exemption 3 then in force.²¹ The amended

²⁰ Pub. L. No. 94-409, 90 STAT. 1241, 1247 (1976). Previously, Exemption 3 simply shielded material "specifically exempted from disclosure by statute." 5 U.S.C. § 552(b)(3) (1970).

²¹ The *Robertson* Court reasoned that there was no indication that Congress intended to exclude any existing nondisclosure statute from Exemption 3 and declined to infer a series of selective repeals by implication. Instead, it concluded that Congress' response to the problems posed by existing nondisclosure statutes "was to permit the numerous laws then extant allowing confidentiality to stand[.]" 422 U.S. at 266. The Court proceeded to find that § 1104 of the Federal Aviation Act of 1958, 49 U.S.C. § 1504 (1976), came within Exemption 3. That section now provides in relevant part:

Any person may make written objection to the public disclosure of information contained in any application, report, or document filed pursuant to the provisions of this chapter or of information obtained by the Board or the Secretary of Transportation, pursuant to the provisions of this chapter, stating the grounds for such objection. Whenever such objection is made, the Board or Secretary of Transportation shall order such information withheld from public disclosure when, in their judgment, a disclosure of such information would adversely affect the interests of such person and is not required in the interest of the public. * * *

The Conference Committee report on the final version of the 1976 Exemption 3 amendments states: "The conferees intend this

text and its legislative history make clear that Congress did not want the exemption to be triggered by every statute that in any way gives administrators discretion to withhold documents from the public.²² On the contrary, Congress intended exemption from the FOIA to be a legislative determination and not an administrative one.²³ It provided that only explicit nondisclosure statutes that evidence a congressional determination that certain materials ought to be kept in confidence will be sufficient to qualify under the exemption. But it did provide that such statutes would be sufficient.²⁴

With this as background, we turn to Section 122 of the Patent Act, which provides:

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

35 U.S.C. § 122 (1976). In *Irons v. Gottschalk*, 548 F.2d 992 (D.C. Cir. 1976), *cert. denied*, 434 U.S. 965 (1977), a panel of this court assumed that Section 122 was an express statutory exemption for purposes of the prior version of Exemption 3.²⁵ In a footnote to that decision

language to overrule the decision of the Supreme Court in *Administrator, FAA v. Robertson* * * *." H.R. Rep. No. 94-1441, 94th Cong., 2d Sess. 25 (1976) (Conference Report).

²² See *American Jewish Congress v. Kreps*, 574 F.2d 624, 628-630 (D.C. Cir. 1978); *Seymour v. Barabba*, 559 F.2d 806, 807 (D.C. Cir. 1977).

²³ See generally *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 614-618 (9th Cir. 1978); *American Jewish Congress v. Kreps*, *supra* note 22, 574 F.2d at 628 n.34.

²⁴ See *Seymour v. Barabba*, *supra* note 22.

²⁵ See also *Sears v. Gottschalk*, *supra* note 6.

we made reference to the changes wrought by Congress via the Government in the Sunshine Act and expressed the view that those changes would not alter the outcome of that case.²⁶ While indicative of that panel's view of the new statute, we do not think the footnote in *Irons*, appended as it was to a decision in a case argued under the prior statute, is properly elevated to a *holding* binding upon us today. Thus it is on an at least formally clean slate that we now consider the matter.

We recognize at the outset that Section 122 fails to satisfy fully the first part of the proviso in Exemption 3. The Patent Act simply is not a statute that requires nondisclosure "in such a manner as to leave *no* discretion on the issue." (Emphasis added.) Rather it permits the Commissioner to release information concerning patent applications when he finds there exist the appropriate "special circumstances." But the mere presence of some residual administrative discretion does not take Section 122 out of Exemption 3. It is quite clear that the requirements set forth in that exemption are phrased in the disjunctive, and it is therefore sufficient if either prong of the proviso is satisfied. We believe that Section 122 does satisfy the second prong because it "refers to particular types of matters to be withheld"—namely, patent applications and information concerning them.²⁷ Moreover, taking a somewhat broader view, we would in any event be extremely reluctant to impute to Congress an intent to eliminate the long-standing confidentiality accorded to patent applications absent rather unambiguous indications that this is what Congress really wanted. There can be little doubt that a holding permit-

²⁶ *Irons v. Gottschalk*, *supra* note 9, 548 F.2d at 994 n.3.

²⁷ *Id.* See also *Lee Pharmaceuticals v. Kreps*, *supra* note 23, 577 F.2d at 615-617. In that decision the Ninth Circuit reached a conclusion similar to our own on the relationship between § 122 and Exemption 3.

ting FOIA access to such applications would jeopardize the patent system by permitting competitors to divine or actually to secure information concerning inventions prior to the issuance of a patent.²⁸ Indeed, were such access routinely to be permitted would-be applicants might be deterred from seeking patent protection in the first place. The need for confidentiality, in short, seems close to the core of the patent system. We decline to infer an intent to abridge that confidentiality from legislative materials that in no way imply it.

In sum, we are simply not faced today with the kind of blanket authorization to keep secret which was at issue in *Robertson*, *supra*, and which under the Government in the Sunshine Act is clearly to yield to the FOIA's disclosure requirement. Instead we are presented with a statute that (1) affirmatively requires nondisclosure (2) of rather particular sorts of material (3) subject only to a discretionary but apparently narrow "special circumstances" exception which (4) has not historically been used to permit anything resembling general access to the materials in suit and (5) could not be so used without doing violence to the statutory scheme. In our judgment these are precisely the sorts of factors on which Congress intended the application of Exemption 3 to turn.

III

Having determined that Section 122 is an Exemption 3 nondisclosure provision, we now turn to the effect of that section on the documents in suit. That it shields patent applications themselves is obvious from the text, and we think it equally clear that this applies to pending and abandoned applications alike.²⁹ But appellant has

²⁸ See *Lee Pharmaceuticals v. Kreps*, *supra* note 23, 577 F.2d at 616.

²⁹ The Fourth Circuit held that § 122 applies to both pending and abandoned applications in *Sears v. Gottschalk*, *supra* note 6, 502

not requested actual patent applications, whether pending or abandoned. It seeks only PTO decisions granting or denying petitions for earlier filing dates. We must, therefore, decide whether these administrative decisions qualify as "information concerning" patent applications for purposes of Section 122.

Appellant invites us to conclude that the materials at issue here do not so qualify and, in the alternative, suggests that even if they do they must be released once those portions reasonably deemed confidential have been deleted. We decline to follow appellant's lead on both counts. The first, we believe, is foreclosed by statute. It would strain language to the breaking point to conclude that decisions concerning the filing date of patent applications are not "information concerning" those applications. Nor is the conclusion to which the statutory language leads us an irrational one. Earlier filing date decisions identify the applicant, the invention, and the filing date. As a result, their disclosure would lead to some of the same harms as would the disclosure of the applications themselves.

Appellant's second suggestion is somewhat more attractive. Indeed, it seems superficially to offer a means of reconciling the disclosure mandate of the FOIA with the exigencies of the patent system.³⁰ Nonetheless, we are

F.2d at 128-131. We implicitly followed that decision in *Irons v. Gottschalk*, *supra* note 9, 548 F.2d at 995, and the Ninth Circuit followed suit in *Lee Pharmaceuticals v. Kreps*, *supra* note 23. We are aware of no reason to adopt a different course now. On the contrary, we find the Fourth Circuit's reasoning fully persuasive.

³⁰ A rule of partial deletion was chosen by this court in *Irons v. Gottschalk*, *supra* note 9, to achieve just such a reconciliation. There appellant had requested all unpublished manuscript decisions of the Patent Office—a category of documents that would include some that were reachable under the FOIA and others that were exempt under § 122 and Exemption 3. Relying in part on *Vaughn v. Rosen*, 484 F.2d 820 (D.C. Cir. 1973), *cert. denied*, 415 U.S. 977 (1974), we concluded:

constrained to reject it. Congress seems to have intended to draw a bright line shielding from disclosure *all* information concerning patent applications. Had it wanted to insulate only some information concerning them, or otherwise to inaugurate a regime of selective excision, it could easily have so specified. Instead, it enacted a flat prohibition on disclosure which we do not feel free to ignore.³¹ Accordingly, we conclude that the documents in suit are exempt *in toto* insofar as they relate to pending or abandoned patent applications.

IV

We have restricted our discussion thus far to those of the PTO's early filing date decisions that relate to pending or abandoned patent applications. Still unaddressed is the proper treatment of those decisions that relate to applications which have issued as patents. Such decisions are, of course, contained in files that are open for public inspection.³² Accordingly, it would be difficult to contend

Those portions of the decisions which contain protected information can be excised in order that the non-exempt portions can be disclosed. Extending this reasoning to entire volumes, we find that the volumes cannot be denied the appellant *in toto* solely on the ground that the volumes contain exempt information. Again, the exempt portions of the volumes can be removed prior to disclosure to the appellant.

548 F.2d at 996. We proceeded to remand to the District Court for a determination of which materials were exempt.

³¹ Appellant contends that the "segregability clause" of the FOIA requires us to order the sort of selective deletion it seeks. That clause provides that "[a]ny reasonably segregable portion of a record shall be provided to any person requesting such record after deletion of the portions which are exempt under this subsection." 5 U.S.C. § 552(b). We have no doubt that were we to conclude that a portion of the documents in suit were not exempt, the proper result would be to order release of expurgated versions. But since we conclude that § 122 exempts the PTO's earlier filing date decisions in their entirety, the segregability clause has no application to the present case.

³² See text at note 8 *supra*.

that they are nonetheless insulated from the FOIA by virtue of Section 122 and Exemption 3.³³ Indeed, to assert that a document in a public file is exempt from the Act because its disclosure is specifically prohibited by statute would make little sense. Thus we conclude that the FOIA applies with full force to filing date decisions in this category.

As to one group of these decisions—those denying an earlier filing date—the PTO has agreed to provide access as well as an index,³⁴ and appellant is apparently satisfied. The disposition with regard to the other group—decisions granting an earlier filing date—is considerably more muddled. The PTO appears to have denied FOIA access,³⁵ and the District Court opinion fails to discuss the matter.³⁶ Appellant's brief does not focus on this group of decisions, and the agency's submissions are similarly uninformative. It may be that the *status quo* with regard to these decisions is satisfactory to appellant in light of their location in public files. On the other hand, the fact of satisfactory access does not appear in the materials before us, and it is at least a fair inference from what we do have that appellant seeks something more.³⁷ Accordingly, we believe it necessary to remand so that the District Court can determine the status of

³³ The possibility that patent files as well as pending and abandoned applications might fall within the purview of § 122 is raised in *Irons v. Gottschalk*, *supra* note 9, 548 F.2d at 995, and *Sears v. Gottschalk*, *supra* note 6, 502 F.2d at 128. Neither opinion, however, stands for the proposition that patent files would thereby come within FOIA Exemption 3.

³⁴ App. 36.

³⁵ App. 37. *See* note 12 *supra*.

³⁶ App. 81-82.

³⁷ It is certainly conceivable that locating the kinds of decisions appellant seeks in public patent files would be so great a burden as to make their availability all but meaningless.

these documents and take appropriate steps to make sure that the requirements of the FOIA are complied with.

One of two provisions of the Act may govern this group of decisions. The first is Section 552(a)(2), which requires agencies to make available and index

(A) final opinions * * * made in the adjudication of cases;

(B) those statements of policy and interpretations which * * * are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public[.]

The second is Section 552(a)(3), which provides:

Except with respect to the records made available under paragraphs (1) and (2) of this subsection [552(a)], each agency, upon any request for records which (A) reasonably describes such records and (B) is made in accordance with published rules * * *, shall make the records promptly available * * * .

If the former applies, the agency's responsibilities are at an end once it provides a reasonable index of the requested decisions and makes the files containing them available. If the latter is apposite, the agency need not make an index, but it must produce the actual documents whenever a satisfactory request is made.

The District Court held that decisions granting an earlier filing date do not, standing alone, come within Section 552(a)(2).³⁸ It provided no reasons for this conclusion, and in our judgment the issue is not free from doubt. On the contrary, decisions granting earlier filing date petitions do finally determine a distinct issue

³⁸ App. 83.

in the adjudication of patent cases—whether the filing date assigned was appropriate. They seem to give reasons for that determination and could in many ways provide a glimpse of precisely the sorts of “secret law” which it was one purpose of the FOIA to make available.³⁹ Indeed, if the consequence of affirming the District Court holding with regard to Section 552(a)(2) were to render these decisions secret, we might well be constrained to reverse, recognizing full well that this would bring us onto waters in some sense uncharted.⁴⁰ In fact, however, this is not the consequence, as is detailed below, and we are content to affirm, saving for another day an exploration of what sorts of decisions of collateral issues may be final orders for Section 552(a)(2) purposes.

Our disposition leaves the District Court with two broad possibilities. It may conclude that the decisions at issue here, although not themselves within Section 552(a)(2), must nonetheless be indexed as part of an index required for the PTO decisions that actually grant patents. These latter decisions presumably fit within Section 552(a)(2). Alternatively, if the District Court concludes that decisions disposing of earlier filing date petitions are neither directly nor derivatively within the Section

³⁹ See Davis, *The Information Act: A Preliminary Analysis*, 34 U. CHI. L. REV. 761, 797 (1967); *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 152-153 (1975).

⁴⁰ The problem is that the decisions in suit do not fit smoothly into the § 552(a)(2) categories. If the test for “final opinion” is to be based in large measure on finality—and the *Sears* case, *supra* note 39, 421 U.S. at 158, 160, suggests that it is—these threshold decisions are problematic. Nor do they comport readily with the other categories in § 552(a)(2). In light of the considerations set forth in text, we do not now consider under what circumstances a decision may be deemed so collateral to an ongoing adjudicative procedure that it appears final in and of itself for § 552(a)(2) purposes.

552(a)(2) indexing requirement, it must order disclosure pursuant to Section 552(a)(3) where appropriate.⁴¹

V

In sum, we find the documents at issue to be exempt from the FOIA insofar as they relate to pending and abandoned applications and fully subject to that Act insofar as they relate to applications that have issued as patents. As to the latter, we remand for a determination of the proper disposition of those decisions (if any) as to which there exists a continuing dispute.⁴² With the exception of the issues left open by this remand, the decision of the District Court is affirmed.

So ordered.

⁴¹ It may turn out that the agency can best meet its responsibilities under § 552(a)(3) by preparing and releasing something closely resembling the sort of index it would have been required to prepare had § 552(a)(2) been applicable.

⁴² As we have already noted, *see* page 2 *supra*, the agency may want to take another look at the way it has exercised its discretionary authority to release some exempt documents. More particularly, its treatment of early filing date decisions lodged in abandoned application files appears curious. It released (in expurgated form) only those denying earlier filing dates. Yet there appears to be no reason to treat those granting earlier filing dates any differently.

16a

UNITED STATES COURT OF APPEALS
DISTRICT OF COLUMBIA CIRCUIT

No. 78-1200

Irons and Sears v. Dann, Commr. of Patents

BEFORE: Wright, Chief Judge; McGowan, Tamm, Leventhal, Robinson, MacKinnon, Robb, Wilkey, and Wald, Circuit Judges

ORDER

Filed August 31, 1979

The suggestion for rehearing *en banc* filed by appellants (Irons and Sears) having been transmitted to the full Court and no judge in regular active service having requested a vote with respect thereto, it is

ORDERED, by the Court, that appellants' aforesaid suggestion for rehearing *en banc* is denied.

Per Curiam
FOR THE COURT:

/s/ George A. Fisher
GEORGE A. FISHER
Clerk

17a

UNITED STATES COURT OF APPEALS
DISTRICT OF COLUMBIA CIRCUIT

No. 78-1200

Irons and Sears v. Dann, Commr. of Patents

BEFORE: Wright, Chief Judge; Robinson and Robb, Circuit Judges

ORDER

Filed August 31, 1979

Upon consideration of appellants' (Irons and Sears) petition for rehearing, it is

ORDERED, by the Court, that appellants' aforesaid petition for rehearing is denied.

Per Curiam
FOR THE COURT:

/s/ George A. Fisher
GEORGE A. FISHER
Clerk

DISTRICT COURT, DISTRICT OF COLUMBIA

No. 75-1408

Irons and Sears v. Dann, Commr. Pats.

MEMORANDUM

Filed January 23, 1978

Plaintiff, a law partnership engaged in patent practice, brought this action pursuant to the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552, as amended, seeking access to all decisions of the Commissioner of Patents subsequent to July 4, 1967, pertaining to the grant or refusal of an earlier filing date than the filing date originally established by the Patent Office for patent applications, and to all indices which in any way relate to these decisions. The matter is before the Court on defendant's motion to dismiss, or in the alternative, for summary judgment. For the reasons discussed below, the Court finds that there are no genuine issues of material fact,¹ and that defendant is entitled to judgment as a matter of law.

Patent applications fall into three categories: patent applications which are before the patent examiner for consideration as to whether they conform to the requirements of the law for issuance of patent (pending patent applications); patent applications in which proceedings before the examiner have been terminated without issuance of a patent (abandoned patent applications); and patent applications which have been issued as patents (patent files).² Patent files are open to the public. Pending and abandonment patent applications are maintained

¹ Plaintiff has claimed that discovery is necessary in this case to explore defendant's descriptions of Patent Office practice and procedure. The Court rejects this claim. The issues herein are purely legal ones and require no discovery.

² See 35 U.S.C. § 1, et seq. See also *Sears v. Gottschalk*, 502 F.2d 122, 124 (4th Cir. 1974), cert. denied, 425 U.S. 904 (1976).

in confidence by the Patent and Trademark Office pursuant to the dictates of 35 U.S.C. § 122.³

The filing date of a patent application is the date on which the complete application, acceptable for placing on the files for examination, is received in the Patent and Trademark Office.⁴ An application is considered incomplete if it lacks any of the requisite statutory elements. The filing date of an incomplete application is the date on which the last missing element is received. Filing dates are the critical measure of an applicant's rights under the Patent Act and are referred to during the examination proceedings to determine whether a patent may be lawfully granted.⁵

If an application is ruled incomplete, it is not given any filing date and the applicant is so notified. The applicant may complete the application, receive a filing date upon completion, and see the application go on to the appropriate examining group. The applicant may, however, contest the determination that the application is incomplete or contest the filing date assigned, and may petition the Commissioner to review the determination made and to assign an earlier filing date.⁶ Decisions are

³ 35 U.S.C. § 122 provides:

Applications for patents shall be kept in confidence by the Patent and Trademarks Office and no information concerning the same given without the authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

See also 37 CFR § 1.14(a) and (b).

⁴ The requirements for a complete application are spelled out in 35 U.S.C. § 111 and 37 CFR § 1.51, et seq.

⁵ See 35 U.S.C. § 102 for the relevant time periods governing patent grants.

⁶ Decisions are rendered pursuant to 37 CFR § 1.183 which provides:

In an extraordinary situation, which justice requires, any requirement of the regulations in this part which is not a

rendered by letter to the applicant and it is these letters, granting or denying earlier filing dates, that are the subject matter of this litigation.

Plaintiff made its initial FOIA request for access to filing date decisions and indices on March 14, 1975 and later narrowed that request to those documents subsequent to the date of enactment of the Freedom of Information Act. By letter dated April 23, 1975, plaintiff was notified that its request was granted in part and denied in part. The Patent and Trademark Office agreed to disclose decisions refusing to grant earlier filing dates in regard to patent files and abandoned patent applications, after the deletion of confidential material, and also indices of such decisions. However, the Patent Office refused to disclose decisions denying earlier filing dates in pending patent applications and decisions granting earlier filing dates in either pending or abandoned patent applications, citing the confidentiality requirement of 35 U.S.C. § 122 and noting with respect to decisions granting earlier filing dates that such were not indexed since in the judgment of the Patent office these decisions were not final opinions or orders within the meaning of the FOIA. Plaintiff appealed the partial denial of its FOIA request and on June 23, 1975, the Commissioner of Patents and Trademarks concurred in the refusal to disclose. Plaintiff filed the instant action on August 27, 1975.

The major issue before the Court is whether filing date decisions in connection with pending and abandoned patent applications are exempt from disclosure under the FOIA pursuant to 5 U.S.C. § 552(b)(3). A secondary issue involved in this case is whether indices with regard to the grant of earlier filing dates are required under 5 U.S.C. § 552(a)(2).⁷

requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

⁷ Defendant raised a third issue in his motion papers: that the Patent and Trademark Office need not disclose decisions granting

FOIA exemption 3, 5 U.S.C. § 552(b)(3), exempts from disclosure matters that are

"... specifically exempted from disclosure by statute (other than section 552b of this title), provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld."

The Court is satisfied that 35 U.S.C. § 122 comes within the ambit of FOIA exemption 3. *Irons v. Gottschalk*, 548 F.2d 992, 994 n. 3, (D.C. Cir. 1976); *Sears v. Gottschalk*, *supra* at 130-131. However, this does not end the Court's inquiry here. Mandatory disclosure of pending and abandoned patent applications is foreclosed by 35 U.S.C. § 122. Similarly foreclosed is mandatory disclosure of "information concerning the same." The question is whether filing date decisions constitute *in toto* "information concerning" applications for patents. After careful review of the entire record in this case, the Court concludes that the decisions of the Commissioner granting or denying earlier filing dates for patent applications qualify as information concerning those applications so as to be exempt from mandatory FOIA disclosure pursuant to 35 U.S.C. § 122 and 5 U.S.C. § 552(b)(3). Filing dates are a critical part of the patent application. Decisions with respect to the grant or denial of earlier filing dates are likewise a part of the patent application. The Court is persuaded that filing date decisions differ

earlier filing dates because plaintiff has failed to frame its request with sufficient specificity to properly identify the subject matter of the request and enable defendant to locate these items. The Court rejects defendant's argument on this point. The Court is satisfied that defendant knows what plaintiff wishes to see and where generally to locate it. The Court concludes that the decisions sought constitute "identifiable records" within the meaning of 5 U.S.C. § 552(a)(3). See *Sears v. Gottschalk*, *supra*, at 125.

significantly from the unpublished manuscript decisions in issue in *Irons v. Gottschalk*, *supra*, and held partially disclosable there. The Court concludes that in light of the statutory purposes of 35 U.S.C. § 122^a and given the type of documents involved, there is no basis for awarding mandatory access under the FOIA to the Commissioner's decision granting or denying earlier filing dates in pending or abandoned patent applications.

Nor is there any basis for requiring defendant to index decisions granting earlier filing dates. The Court is satisfied that such decisions are not final opinions or orders in the adjudication of cases or statements of policy or interpretations within the meaning of 5 U.S.C. § 552(a) (2).⁹

Summary Judgment for Defendant herein is, therefore, appropriate.

/s/ Aubrey E. Robinson, Jr.
AUBREY E. ROBINSON, JR.
United States District Judge

January 23, 1978
(Date)

^a See *Sears v. Gottschalk*, *supra*, at 128-130.

⁹ See, for e.g., in a different factual context, *Federal Power Commission v. Texaco, Inc.*, 377 U.S. 33, 45 (1964).

ORDER

Filed January 23, 1978

In accordance with the Memorandum filed herewith, it is by the Court this 23rd day of January, 1978,

ORDERED, that Defendant's Motion for Summary Judgment be and it is hereby GRANTED, and judgment shall be entered for Defendant herein.

/s/ Aubrey E. Robinson, Jr.
AUBREY E. ROBINSON, JR.
United States District Judge